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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,224	03/22/2001	Michael L. Boyer II	060960-5013-US	2289
28977	7590	07/01/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP			STEWART, ALVIN J	
1701 MARKET STREET			ART UNIT	
PHILADELPHIA, PA 19103-2921			PAPER NUMBER	
			3738	

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/814,224

Applicant(s)

BOYER ET AL.

Examiner

Alvin J Stewart

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/12/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25, 27, 29-32, 34-41, 43, 44, 46-52 and 54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25, 27, 29-32, 34-41, 43, 44, 46-52 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/12/05 has been entered.

### ***Response to Amendment***

Claims 26, 28, 33, 42, 45 and 53 are canceled.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25, 27, 29-32, and 34-41, 43, 44, 46-52 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al US Patent 6,200,347 B1.

Anderson et al disclose an intervertebral disc (see Fig. 11B and col. 1, lines 10-11) comprising a cancellous body (73, see col. 17, lines 45-48) with first and second ends, a plurality of holes extending between the ends (see Fig. 11B), two cortical end caps (70) having receiving regions, and a plurality of cortical struts (7). The receiving regions are the plurality of holes (5), the bearing surface is the surface created at each hole along the thickness of each cortical cap and the end is the part created at the rim top surface of each hole cap.

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Regarding claim 41, At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the aperture of the Anderson et al reference by having a recess that does not extend completely through the end cap because Applicant has not disclosed that by having a recess that does not extend completely through the end cap provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a recess that extends completely through the end cap because it would perform equally well.

Therefore, it would have been an obvious matter of design choice to modify the Anderson et al reference to obtain the invention as specified in claim.

In order to be given patentable weight, a functional recitation must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language.

*In re Fuller*, 1929 C.D. 172; 388 O.G. 279.

The claims disclosed above are given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

Regarding claim 27, the struts has been entered in opening 5 by pushing the struts through the opening 5. Therefore, it has been press fitted into the opening.

Regarding claims 29 and 30, see col. 3, lines 21-23 and col. 48, lines 35-41.

Regarding claims 31 and 32, the cancellous bone is the osteoconductive material (see col. 17, lines 45-48). Natural bone promotes the growth of bone tissue.

Regarding claims 36-38, see Figs. 24, 25 and 10.

Regarding claims 39 and 41, the whole structure is capable of distributing the forces exerted to the implant. It has been held that a claim is anticipated if each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice. *Kalman vs. Kimberly-Clark Corp.*, 218 USPQ 789.

Anderson discloses the invention substantially as claimed. However, Anderson et al does not disclose a cap having a recess that does not extend completely through the end cap and a body having a cylindrical shape.

Anderson et al teaches in another embodiment (see Fig. 10) an implant comprising a cylindrical shape.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to change the rectangular shape to a circular shape and discloses a recess region in the cortical cap that does not extend completely through the end cap because Applicant has not disclosed that the circular shape and the recess that does not extend completely through the end cap provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the rectangular shape and the recess that does not extend completely through the end cap because the rectangular shape will promote osteoinductivity and cellularization, provides stability, mechanical strength and the holes extending completely through the end cap will keep the implant attached together.

Therefore, it would have been an obvious matter of design choice to modify the Anderson et al to obtain the invention as specified in claims 28, 33, 45 and 52-53.

Regarding claims 41 and 54, the Examiner has not given patentable weight to the "wherein" clause because a "wherein" clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim. See *Texas Instruments Inc. v. International Trade Commission*, 26 USPQ2d 1010 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 Uspq2d 1747 (Fed. Cir. 2001).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 703-305-0277. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 22, 2005.

*A. Stewart*  
**ALVIN J. STEWART**  
**PRIMARY EXAMINER**